



Reports of Cases

JUDGMENT OF THE COURT (Fourth Chamber)

4 March 2020*

(Appeal — EU trade mark — Regulation (EC) No 207/2009 — Word and figurative marks ‘BURLINGTON’ — Opposition of the proprietor of the earlier word and figurative marks ‘BURLINGTON’ and ‘BURLINGTON ARCADE’ — Article 8(1)(b) — Likelihood of confusion — Nice Agreement — Class 35 — Concept of ‘retail services’ — Article 8(4) — Passing-off — Article 8(5) — Reputation — Criteria for assessment — Similarity between the goods and services — Opposition rejected)

In Joined Cases C-155/18 P to C-158/18 P,

FOUR APPEALS under Article 56 of the Statute of the Court of Justice of the European Union, brought on 22 February 2018,

Tulliallan Burlington Ltd, established in St Helier (Jersey), represented by A. Norris, Barrister,

appellant in Cases C-155/18 P to C-158/18 P,

the other parties to the proceedings being:

European Union Intellectual Property Office (EUIPO), represented by M. Fischer and D. Botis, acting as Agents,

defendant at first instance,

Burlington Fashion GmbH, established in Schmallenberg (Germany), represented by A. Parr, Rechtsanwältin,

intervener at first instance,

THE COURT (Fourth Chamber),

composed of M. Vilaras, President of the Chamber, S. Rodin, D. Šváby, K. Jürimäe (Rapporteur) and N. Piçarra, Judges,

Advocate General: G. Hogan,

Registrar: M. Longar, Administrator,

having regard to the written procedure and further to the hearing on 10 April 2019,

after hearing the Opinion of the Advocate General at the sitting on 26 June 2019,

* Language of the case: English.

gives the following

Judgment

- 1 By its appeals, Tulliallan Burlington Ltd asks the Court of Justice to set aside the judgments of the General Court of the European Union of 6 December 2017, *Tulliallan Burlington v EUIPO — Burlington Fashion (Burlington)* (T-120/16, EU:T:2017:873), of 6 December 2017, *Tulliallan Burlington v EUIPO — Burlington Fashion (BURLINGTON THE ORIGINAL)* (T-121/16, not published, EU:T:2017:872), of 6 December 2017, *Tulliallan Burlington v EUIPO — Burlington Fashion (Burlington)* (T-122/16, not published, EU:T:2017:871), and of 6 December 2017, *Tulliallan Burlington v EUIPO — Burlington Fashion (BURLINGTON)* (T-123/16, not published, EU:T:2017:870) (‘the judgments under appeal’), by which the General Court dismissed its actions seeking the annulment of four decisions of the Fourth Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 11 January 2016 (Cases R 94/2014-4, R 2501/2013-4, R 2409/2013-4 and R 1635/2013-4, together, ‘the decisions at issue’), relating to four sets of opposition proceedings between Tulliallan Burlington and Burlington Fashion GmbH.

Legal context

- 2 Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) was amended by Council Regulation (EC) No 1891/2006 of 18 December 2006 (OJ 2006 L 386, p. 14) (‘Regulation No 40/94’).
- 3 Regulation No 40/94 was repealed and replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), which entered into force on 13 April 2009. Regulation No 207/2009 was amended by Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 (OJ 2015 L 341, p. 21), which entered into force on 23 March 2016. Regulation No 207/2009, as amended, was repealed and replaced, with effect from 1 October 2017, by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1).
- 4 Having regard to the dates on which the applications for registration of the trade marks applied for were made — in the present case on 19 August 2008 for registrations No 982020 and No 982021, on 2 April 2009 for registration No 1007952 and on 8 September 2009 for registration No 1017273, which are determinative for the purposes of identifying the applicable substantive law — the present proceedings are governed, first, by the procedural provisions of Regulation No 207/2009 and, secondly, by the substantive provisions of Regulation No 40/94 for registrations No 982020, No 982021 and No 1007952 and by the substantive provisions of Regulation No 207/2009 for Registration No 1017273. The substantive provisions of those two relevant regulations are, in essence, identical for the purposes of the present proceedings.
- 5 Article 8 of Regulation No 40/94, entitled ‘Relative grounds for refusal’, the provisions of which were reproduced in Article 8 of Regulation No 207/2009, provided:

‘1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

...

- (b) if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

...

4. Upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Community legislation or the law of the Member State governing that sign:

- (a) rights to that sign were acquired prior to the date of application for registration of the Community trade mark, or the date of the priority claimed for the application for registration of the Community trade mark;
- (b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

5. Furthermore, upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with or similar to the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where in the case of an earlier Community trade mark the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.'

- 6 Under Article 43(1) to (3) of Regulation No 40/94, entitled 'Examination of opposition', the provisions of which were reproduced in Article 42 of Regulation No 207/2009:

'1. In the examination of the opposition the Office shall invite the parties, as often as necessary, to file observations, within a period set them by the Office, on communications from the other parties or issued by itself.

2. If the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.

3. Paragraph 2 shall apply to earlier national trade marks referred to in Article 8(2)(a), by substituting use in the Member State in which the earlier national trade mark is protected for use in the Community.'

7 Article 44 of Regulation No 40/94, entitled ‘Withdrawal, restriction and amendment of the application’, the provisions of which were reproduced in Article 43 of Regulation No 207/2009, provided:

‘1. The applicant may at any time withdraw his Community trade mark application or restrict the list of goods or services contained therein. Where the application has already been published, the withdrawal or restriction shall also be published.

2. In other respects, a Community trade mark application may be amended, upon request of the applicant, only by correcting the name and address of the applicant, errors of wording or of copying, or obvious mistakes, provided that such correction does not substantially change the trade mark or extend the list of goods or services. Where the amendments affect the representation of the trade mark or the list of goods or services and are made after publication of the application, the trade mark application shall be published as amended.’

8 Article 63 of Regulation No 207/2009, which appears in Title VII of that regulation entitled ‘Appeals’, provides in paragraph 2:

‘In the examination of the appeal, the Board of Appeal shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Board of Appeal, on communications from the other parties or issued by itself.’

9 Article 75 of Regulation No 207/2009 states:

‘Decisions of [EUIPO] shall state the reasons on which they are based. They shall be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments.’

10 Under Article 76 of that regulation:

‘1. In proceedings before it [EUIPO] shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, [EUIPO] shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

2. [EUIPO] may disregard facts or evidence which are not submitted in due time by the parties concerned.’

11 Article 151(1) and (2) of that regulation provides:

‘1. An international registration designating the [European Union] shall, from the date of its registration pursuant to Article 3(4) of the Madrid Protocol or from the date of the subsequent designation of the [Union] pursuant to Article 3ter(2) of the Madrid Protocol, have the same effect as an application for a[n EU] trade mark.

2. If no refusal has been notified in accordance with Article 5(1) and (2) of the Madrid Protocol or if any such refusal has been withdrawn, the international registration of a mark designating the [Union] shall, from the date referred to in paragraph 1, have the same effect as the registration of a mark as a[n EU] trade mark.’

12 Article 156(1) to (3) of that regulation provides:

‘1. International registration designating the [Union] shall be subject to opposition in the same way as published [EU] trade mark applications.

2. Notice of opposition shall be filed within a period of three months which shall begin six months following the date of the publication pursuant to Article 152(1). The opposition shall not be treated as duly entered until the opposition fee has been paid.

3. Refusal of protection shall take the place of refusal of a[n EU] trade mark application.’

- 13 Rule 19 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1), as amended by Commission Regulation (EC) No 1041/2005 of 29 June 2005 (OJ 2005 L 172, p. 4), entitled ‘Substantiation of the opposition’, provides in paragraph 1:

‘[EUIPO] shall give the opposing party the opportunity to present the facts, evidence and arguments in support of his opposition or to complete any facts, evidence or arguments that have already been submitted pursuant to Rule 15(3), within a time limit specified by it ...’

- 14 Under Rule 50(1) of that regulation:

‘Unless otherwise provided, the provisions relating to proceedings before the department which has made the decision against which the appeal is brought shall be applicable to appeal proceedings *mutatis mutandis*.

...

Where the appeal is directed against a decision of an Opposition Division, the Board shall limit its examination of the appeal to facts and evidence presented within the time limits set in or specified by the Opposition Division in accordance with the Regulation and these Rules, unless the Board considers that additional or supplementary facts and evidence should be taken into account pursuant to Article [76(2) of Regulation No 207/2009].’

- 15 The Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, of 15 June 1957, as revised and amended (‘the Nice Agreement’), was concluded on the basis of Article 19 of the Paris Convention for the Protection of Industrial Property, signed in Paris on 20 March 1883, as last revised at Stockholm on 14 July 1967 and as amended on 28 September 1979 (*United Nations Treaty Series*, Vol. 828, No 11851, p. 305), which reserves for the countries of the Union the right to make separately between themselves special agreements for the protection of industrial property.

- 16 In the classification which the Nice Agreement establishes, Class 35, relating to services, is headed as follows:

‘Advertising; business management; business administration; office functions.’

- 17 The Explanatory Note relating to that class states:

‘Class 35 includes mainly services rendered by persons or organisations principally with the object of:

1. help in the working or management of a commercial undertaking, or
2. help in the management of the business affairs or commercial functions of an industrial or commercial enterprise,

as well as services rendered by advertising establishments primarily undertaking communications to the public, declarations or announcements by all means of diffusion and concerning all kinds of goods or services.

This Class includes, in particular:

- the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods; such services may be provided by retail stores, wholesale outlets, through vending machines, mail order catalogues or by means of electronic media, for example, through web sites or television shopping programmes;
- services consisting of the registration, transcription, composition, compilation or systematisation of written communications and registrations, and also the compilation of mathematical or statistical data;
- services of advertising agencies and services such as the distribution of prospectuses, directly or through the post, or the distribution of samples. This Class may refer to advertising in connection with other services, such as those concerning bank loans or advertising by radio.

...'

Background to the disputes and the decisions at issue

- ¹⁸ The background to the proceedings, as set out in the judgments under appeal, may be summarised as follows.

19 On 20 November 2008, 13 August 2009 and 12 November 2009, the intervener before the General Court, Burlington Fashion, filed applications for protection in the European Union of the following international registrations:

- the international registration No 1017273 designating the European Union and conferring protection on the figurative mark represented as follows:



- the international registration No 1007952 designating the European Union and conferring protection on the figurative mark represented as follows:



- the international registration No 982021 designating the European Union and conferring protection on the figurative mark represented as follows:



- the international registration No W982020 designating the European Union and conferring protection on the word mark BURLINGTON.

20 The goods in respect of which the protection was applied for are in Classes 3, 14, 18 and 25, within the meaning of the Nice Agreement, and correspond, for each of those classes, to the following description:

- Class 3: 'Soaps for cosmetic purposes, soaps for textiles, perfumery, ethereal oils, cosmetic preparations for cleaning, caring for and embellishing the skin, the scalp and the hair; toilet articles, included in this class, deodorants for personal use, pre shave and after shave preparations';
- Class 14: 'Jewellery, watches';

- Class 18: ‘Leather and imitations of leather, namely suitcases, bags (included in this class); small leather articles (included in this class), especially purses, wallets, key cases; umbrellas and sunshades in the nature of parasols’;
 - Class 25: ‘Footwear, clothing, headgear, belts’.
- 21 On 12 August 2009, 17 May 2010 and 16 August 2010, Tulliallan Burlington filed notices of opposition pursuant to Article 41 of Regulation No 207/2009 to registration of the marks applied for in respect of the goods in Classes 3, 14 and 18. The opposition was based, inter alia, on the need to protect the following earlier trade marks and rights, of which Tulliallan Burlington is the proprietor:
- the word mark BURLINGTON, registered in the United Kingdom under No 2314342 on 5 December 2003 and duly renewed on 29 October 2012, in respect of services in the following classes:
 - Class 35: ‘Rental and leasing of advertising space; organisation of exhibitions for commercial or advertising purposes; organisation of trade fairs for commercial purposes; advertising and promotion services and information services relating thereto; the bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from general merchandise retail stores’, and
 - Class 36: ‘Rental of shops and offices; leasing of, or management of real estate; leasing of, or space between or within, buildings; real estate management services; information services relating to the rental of shops and offices; real estate services; fund investments; mutual funds’;
 - the word mark BURLINGTON ARCADE, registered in the United Kingdom under No 2314343 on 7 November 2003 and duly renewed on 29 October 2012, in respect of the same services in Classes 35 and 36, within the meaning of the Nice Agreement, and in respect of the services in Class 41 of that agreement corresponding to the following description: ‘Entertainment services; organisation of competitions; organisation of exhibitions; provision of recreation information; presentation of live performances; provision of sports facilities; provision of live music and live entertainment; provision of facilities for live band performances; provision of live entertainment; provision of live music; provision of live musical performances; provision of live shows’;

- the figurative mark reproduced as follows and registered in the United Kingdom under No 2330341 on 7 November 2003 and duly renewed on 25 April 2013, in respect of the abovementioned services in Classes 35, 36 and 41, within the meaning of the Nice Agreement:



- EU figurative mark No 3618857, registered on 16 October 2006, reproduced as follows and limited, as a result of cancellation proceedings No 8715 C, to the following services in Classes 35, 36 and 41, within the meaning of the Nice Agreement:



- Class 35: ‘Advertising and promotion services and information services relating thereto; the bringing together for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from a range of general merchandise retail stores’;
- Class 36: ‘Rental of shops; leasing of, or management of real estate; leasing of, or space between or within, buildings; real estate management services; information services relating to the rental of shops’;
- Class 41: ‘Entertainment services; provision of live entertainment’.

- 22 The grounds relied on in support of the opposition were based on Article 8(1)(b), (4) and (5) of Regulation No 207/2009.
- 23 By decisions of 10 July, 8 October, 8 November and 22 November 2013, the Opposition Division examined the oppositions only on the basis of the earlier EU trade mark No 3618857, upheld the oppositions in respect of the contested goods in Classes 3, 14 and 18 and ordered the intervener to pay the costs.
- 24 On 20 August and 3 and 11 December 2013 and 2 January 2014, Burlington Fashion filed four notices of appeal with EUIPO, pursuant to Articles 58 to 64 of Regulation No 207/2009, against the Opposition Division’s decisions.
- 25 By the decisions at issue, the Fourth Board of Appeal of EUIPO annulled the decisions of the Opposition Division and rejected the oppositions.

26 In the decisions at issue, the Fourth Board of Appeal, found, first, in essence, as regards the application of Article 8(5) of Regulation No 207/2009, that the reputation of the earlier figurative marks had been proven in the relevant territory for the services in Classes 35 and 36, within the meaning of the Nice Agreement, except for the service of ‘bringing together for the benefit of others, a variety of goods, enabling customers to conveniently ... purchase those goods from a range of general merchandise retail stores’. Secondly, as regards the ground based on Article 8(4) of that regulation, the Fourth Board of Appeal found, in essence, that Tulliallan Burlington had not demonstrated that the prerequisites for establishing misrepresentation and damage vis-à-vis the target public had been met. Thirdly, as regards the ground based on Article 8(1)(b) of that regulation, it found, in essence, that since the goods and services at issue were dissimilar, a likelihood of confusion was ruled out, irrespective of the similarity of the marks at issue.

The proceedings before the General Court and the judgments under appeal

27 By applications lodged at the General Court Registry on 23 March 2016, Tulliallan Burlington brought four actions against the decisions at issue.

28 In support of each of those actions, Tulliallan Burlington raised three pleas in law: in essence, the first plea alleged an infringement of Article 8(5) of Regulation No 207/2009, a procedural defect and an infringement of the procedural rules; the second plea in law alleged an infringement of the obligation to state reasons, an infringement of the right to be heard and an infringement of Article 8(4) of that regulation; and the third plea in law alleged an infringement of Article 8(1)(b) of that regulation.

29 By the judgments under appeal, which have identical operative parts and reasoning, the General Court rejected in their entirety the pleas in law put forward by Tulliallan Burlington.

30 As regards the first plea in law, the General Court noted, in paragraph 28 of the judgments under appeal, that the Fourth Board of Appeal had found that, as regards the retail services in Class 35, within the meaning of the Nice Agreement, the reputation of the earlier trade marks had not been proven.

31 In paragraph 33 of the judgments under appeal, the General Court held that the Court of Justice’s interpretation in paragraph 34 of the judgment of 7 July 2005, *Praktiker Bau- und Heimwerkermärkte* (C-418/02, ‘the judgment in *Praktiker*’, EU:C:2005:425), precludes EUIPO’s argument that shopping arcade services are essentially limited to rental and real estate management services and that, therefore, the customers to whom those services are addressed are principally those persons interested in occupying the shops or offices in a shopping arcade.

32 The General Court inferred from this, in paragraph 34 of the judgments under appeal, that, having regard to the wording of Class 35, within the meaning of the Nice Agreement, the concept of ‘retail services’, as interpreted by the Court of Justice in paragraph 34 of the judgment in *Praktiker*, also includes a shopping arcade’s services in relation to sales. It concluded, in the following paragraph of the judgments under appeal, that the strict interpretation of the concept of ‘retail services’ used by the Fourth Board of Appeal was erroneous and that Tulliallan Burlington could rely on the protection of the earlier trade marks’ reputation for all the services covered by the earlier trade marks in Class 35.

33 After recalling, in paragraphs 37 to 42 of the judgments under appeal, the case-law of the Court of Justice on the protection of trade marks with a reputation, provided for in Article 8(5) of Regulation No 207/2009, the General Court held, in paragraph 43 of the judgments under appeal, that, in the present case, Tulliallan Burlington had not submitted to the Fourth Board of Appeal or to the General Court consistent evidence from which it may be concluded that the use of the marks applied for would take unfair advantage of the distinctive character or the repute of the earlier trade marks. In the following paragraphs of the judgments under appeal, the General Court notes that, even though

Tulli Allan Burlington stresses the ‘near uniqueness’ of its earlier trade marks, it has not provided specific evidence capable of substantiating that the use of the marks applied for would make the earlier trade marks less attractive.

- 34 As regards the procedural defect allegedly vitiating the decisions at issue, the General Court found, in paragraph 46 of the judgments under appeal, that the observations of Tulli Allan Burlington had been duly taken into account by the EUIPO adjudicating bodies and, therefore, rejected the objection as unfounded.
- 35 As regards the second plea in law, the General Court rejected, first of all, Tulli Allan Burlington’s argument alleging an infringement of the obligation to state reasons and the argument alleging an infringement of the right to be heard. In particular, the General Court held, in paragraph 53 of the judgments under appeal, that Tulli Allan Burlington had indeed been in a position to submit observations on the conditions laid down by Article 8(4) of Regulation No 207/2009.
- 36 In that regard, the General Court held, in essence, in paragraphs 54 and 55 of the judgments under appeal, that while Tulli Allan Burlington did not develop before the Fourth Board of Appeal the complaint which it had itself raised during the opposition proceedings, namely the infringement of Article 8(4) of Regulation No 207/2009, the Fourth Board of Appeal cannot be criticised for not requesting additional observations from the parties in that connection.
- 37 Secondly, the General Court, after recalling, in paragraphs 56 to 58 of the judgments under appeal, the case-law relating to the conditions laid down in Article 8(4) of Regulation No 207/2009 and the case-law relating to the burden of proof, held that Tulli Allan Burlington had not supplied the factual or legal material necessary to prove that the conditions relating to the application of that provision were duly met, since Tulli Allan Burlington simply stated, before the Fourth Board of Appeal, that it maintained the arguments which it had submitted before the Opposition Division.
- 38 Consequently, the General Court rejected the second plea in law, holding that the Fourth Board of Appeal had been fully entitled to find that Tulli Allan Burlington had not demonstrated that the prerequisites for successful actions for passing-off were duly met.
- 39 As regards the third plea in law, the General Court, after recalling the case-law relating to the likelihood of confusion, in paragraphs 66 to 68 of the judgments under appeal, held that the Fourth Board of Appeal had been fully entitled to find that the goods covered by the marks applied for were dissimilar to the services covered by the earlier trade marks and designated by Classes 35 and 36, within the meaning of the Nice Agreement. As regards more specifically Class 35, the General Court noted, in paragraph 70 of the judgments under appeal, that the EU judicature has determined that, for retail services, it was necessary for the goods offered for sale to be precisely specified. The General Court referred, in that regard, to the judgment in *Praktiker* (paragraph 50) and the judgment of 24 September 2008, *Oakley v OHIM — Venticinque (O STORE)* (T-116/06, EU:T:2008:399, paragraph 44).
- 40 According to the General Court, in the absence of any statement of the goods which may be sold in the various shops comprising a shopping arcade such as Burlington Arcade, no similarity or complementarity could be established between the services covered by the earlier trade marks and the goods covered by the marks applied for. It deduced from this, in paragraph 72 of the judgments under appeal, that Tulli Allan Burlington’s argument that for shopping arcade services there is no need to specify the goods concerned must be rejected, since, having regard to the wording of Class 35 within the meaning of the Nice Agreement, the concept of ‘retail services’, as interpreted by the Court of Justice in paragraph 34 of the judgment in *Praktiker*, includes a shopping arcade’s services in relation to sales.

41 The General Court concluded, in paragraph 74 of the judgments under appeal, that one of the prerequisites referred to in Article 8(1)(b) of Regulation No 207/2009 was not met and that, therefore, the third plea in law had to be rejected and the actions dismissed in their entirety.

Procedure before the Court of Justice and forms of order sought

42 By its appeals, Tulliallan Burlington claims that the Court should:

- set aside the judgments under appeal in so far as they dismiss its actions against the decisions at issue;
- annul the decisions at issue or alternatively refer the cases back to the General Court to be decided in accordance with the decision of the Court of Justice; and
- order EUIPO and Burlington Fashion to pay the costs.

43 EUIPO contends that the Court should:

- set aside the judgments under appeal in so far as the General Court dismissed Tulliallan's applications based on Article 8(1)(b) of Regulation No 207/2009 and the three earlier United Kingdom marks No 2314342, No 2314343 and No 2330341;
- dismiss the appeals as to the remainder; and
- order each party to bear its own costs.

44 Burlington Fashion contends that the Court should:

- dismiss the appeals in their entirety; and
- order Tulliallan Burlington to pay the costs and expenses incurred by Burlington Fashion in connection with the proceedings before the Court of Justice, the General Court and the Fourth Board of Appeal.

45 By decision of the President of the Court of 12 June 2018, the cases were joined for the purposes of the written and oral procedure and of the judgment.

The appeals

46 In support of its appeals, Tulliallan Burlington relies on three grounds, which are identical in the four cases at issue, the first ground alleging an infringement of Article 8(5) of Regulation No 207/2009, the second, an infringement of Article 8(4) of that regulation and the third, an infringement of Article 8(1)(b) of the regulation.

The first ground of the appeals

Arguments of the parties

47 The first ground of appeal raised by Tulliallan Burlington alleges an infringement of Article 8(5) of Regulation No 207/2009 relating to the opposition based on detriment to the earlier mark's reputation.

- 48 The first ground of appeal is, essentially, divided into three parts.
- 49 By the first part of the first ground of appeal, Tulli Allan Burlington submits that, in the light of the evidence on the nature and extent of that reputation, the General Court ought to have found, on a global assessment bearing in mind the factors set out in the judgment of 27 November 2008, *Intel Corporation* (C-252/07, EU:C:2008:655, paragraph 42), that the relevant public would make a link between the earlier trade marks and the marks applied for.
- 50 Shopping arcade services necessitate interaction with the end consumers of the goods sold in the shops. Retailers in a shopping arcade and their goods gain prestige by association with the Burlington Arcade, and the consumer associates the earlier trade marks with the provision of luxury retail goods, in particular goods such as jewellery, leather goods and fragrances.
- 51 Instead of determining whether there was a link between the earlier trade marks and the marks applied for, the General Court proceeded to deal with detriment to distinctive character and unfair advantage.
- 52 By the second part of the first ground of appeal, relating to dilution and unfair advantage, Tulli Allan Burlington submits that the General Court found, in paragraphs 36 to 44 of the judgments under appeal, that it had failed to provide the proof necessary to establish dilution or undue advantage in the light of the criteria laid down in the case-law cited.
- 53 The General Court's approach, in paragraphs 44 and 45 of the judgments under appeal erred in being more demanding than that required by the case-law. Thus, the General Court took into account the reputation of the trade marks of the shops in the shopping arcade, when that reputation was irrelevant. Likewise the General Court took into account the fact that the term 'Burlington' was also the name of other well-known places when it had no evidence that such places had any kind of reputation, which led it to require a standard of proof which was impossible to achieve. The General Court did not, therefore, comply with the approach developed by the Court of Justice in the judgment of 27 November 2008, *Intel Corporation* (C-252/07, EU:C:2008:655).
- 54 Moreover, the General Court failed to take into account the relevant evidence that was provided before it and also before the Fourth Board of Appeal, which was sufficient in the light of the Court of Justice's case-law (judgments of 27 November 2008, *Intel Corporation*, C-252/07, EU:C:2008:655, paragraphs 76 and 77, and of 14 November 2013, *Environmental Manufacturing v OHIM*, C-383/12 P, EU:C:2013:741, paragraph 43).
- 55 By the third part of the first ground of appeal, Tulli Allan Burlington repeats before the Court of Justice one of the pleas which it had raised in support of its applications for annulment of the decisions at issue, according to which the Fourth Board of Appeal, and then the General Court, failed to take into account the arguments submitted before it.
- 56 Burlington Fashion contends that the first ground of the appeals should be rejected in its entirety.
- 57 It contends, as regards the first two parts of the first ground of appeal, that Tulli Allan Burlington has not explained why there would be a risk of unfair advantage or detriment regarding the goods in Classes 3, 14 and 18, within the meaning of the Nice Agreement. First, the earlier trade marks could not be considered unique since an identical or similar sign had also used by Burlington Fashion for a long time in relation to a range of various goods. Secondly, Tulli Allan Burlington also failed to substantiate the link between the signs protected by the earlier trade marks and the Burlington Arcade shopping arcade.
- 58 In addition, it cannot be complained that the General Court imposed on Tulli Allan Burlington a higher standard of proof than that apparent from the case-law. According to that case-law, the opponent must substantiate two autonomous conditions, namely, first, the dispersion in the relevant public's

perception of the image and identity of the trade mark with a reputation and, secondly, the change in the economic behaviour of that public. The General Court correctly stated, in its conclusions in paragraph 43 of the judgments under appeal, that Tulliallan Burlington had not submitted to the Fourth Board of Appeal or to the General Court sufficient evidence to demonstrate that those conditions were met.

- 59 EUIPO contends that the first ground in the appeals must be rejected in its entirety.
- 60 As regards the first part of that ground, EUIPO contends that the General Court expressly referred to the relevant case-law relating to the assessment of the existence of a link between the marks at issue. Referring to the judgment of 27 November 2008, *Intel Corporation* (C-252/07, EU:C:2008:655), the General Court then held, in essence, that the fact that an earlier trade mark enjoys a huge reputation is not sufficient to establish that the use of the mark applied for takes or would be likely to take unfair advantage of, or is or would be likely to be detrimental to, the distinctive character or the repute of the earlier mark. The General Court was correct to stress that the owner of the earlier trade mark had also to show that the economic behaviour of the average consumer of its goods or services has changed or could change because of the use of the mark applied for.
- 61 As regards the second part of the first ground of appeal, EUIPO contends that the General Court correctly held that Tulliallan Burlington had not adduced sufficient evidence to prove such a risk and that the General Court's evidential requirements are not excessively high, since it complied strictly with the Court of Justice's case-law.

Findings of the Court

- 62 By the first part of its first ground of appeal, Tulliallan Burlington submits that the General Court failed, in the judgments under appeal, to examine whether there was a link between the earlier trade marks — which, the General Court acknowledged, had a reputation — and the marks applied for, when the existence of such a link is a prerequisite for establishing detriment to the earlier trade marks, pursuant to Article 8(5) of Regulation No 207/2009.
- 63 In that regard, it must be pointed out that the Court of Justice held, in the judgment of 27 November 2008, *Intel Corporation* (C-252/07, EU:C:2008:655, paragraph 30 and the case-law cited), that the types of injury to trade marks with a reputation, referred to in Article 8(5) of that regulation, where they occur, are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them.
- 64 In the absence of such a link in the mind of the public, the use of the later mark is not likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark (judgment of 27 November 2008, *Intel Corporation*, C-252/07, EU:C:2008:655, paragraph 31).
- 65 The Court has, however, clarified that the existence of such a link is not sufficient, in itself, to establish that there is one of the types of injury referred to in Article 8(5) of that regulation, which constitute the specific condition of the protection of trade marks with a reputation laid down by that provision (judgment of 27 November 2008, *Intel Corporation*, C-252/07, EU:C:2008:655, paragraph 32).
- 66 In order for that provision to apply, three conditions must be met: (i) there must be a link between the earlier trade marks and the marks applied for; (ii) the earlier trade mark cited in opposition must have a reputation; and (iii) there must be a risk that the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark. Those three conditions are cumulative and failure to satisfy one of them is sufficient to preclude that provision from being applied.

- 67 In the present case, in the course of its assessment under Article 8(5) of Regulation No 207/2009, the General Court noted first of all, in paragraph 35 of the judgments under appeal, that Tulliallan Burlington may rely on the protection of the earlier trade marks' reputation for the services covered by the registrations in Class 35, within the meaning of the Nice Agreement. It then noted, in paragraph 36 of those judgments, that the Fourth Board of Appeal had found, in the decisions at issue, that there was no link between the marks at issue and that Tulliallan Burlington had failed to prove that the use of the marks applied for would have taken unfair advantage of, or could be detrimental to, the distinctive character or the repute of the earlier trade marks. The General Court directly proceeded to analyse the third condition laid down in that article, namely that relating to the various risks of detriment, without assessing whether there was a link between the marks at issue.
- 68 After referring to the case-law of the Court of Justice on Article 8(5) of Regulation No 207/2009, in paragraphs 37 to 42 of the judgments under appeal, the General Court simply endorsed, in paragraphs 43 to 45 of those judgments, the decisions at issue, by finding, in essence, that the evidence adduced by Tulliallan Burlington was insufficient to demonstrate that the use of the marks applied for would make the earlier trade marks less attractive.
- 69 As pointed out in paragraph 66 above, in order for Article 8(5) of Regulation No 207/2009 to apply, three cumulative conditions must be met, so that failure to satisfy one of them is sufficient to preclude that provision from being applied.
- 70 It follows that, in the judgments under appeal, the General Court was entitled, without erring in law, to examine, first, whether, on the assumption that consumers will establish a link between the marks applied for and the earlier trade marks, there is a risk that the use of the marks applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade marks. In finding that there was no such risk, the General Court thereby precluded the need to examine the validity of the assumption on which it relied, namely the existence of a link between the earlier trade marks and the marks applied for.
- 71 Consequently, the first part of the first ground of appeal must be rejected as unfounded.
- 72 By the second part of the first ground of appeal, Tulliallan Burlington complains, in essence, that the General Court erred in law in the assessment of whether there was a risk that the use without due cause of the marks applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade marks, within the meaning of Article 8(5) of Regulation No 207/2009.
- 73 In that regard, it must be borne in mind, first, that the types of injury against which Article 8(5) of Regulation No 207/2009 ensures protection for the benefit of trade marks with a reputation are, first, detriment to the distinctive character of the earlier trade mark, secondly, detriment to the repute of that mark and, thirdly, unfair advantage taken of the distinctive character or the repute of that mark (judgment of 27 November 2008, *Intel Corporation*, C-252/07, EU:C:2008:655, paragraph 27).
- 74 Just one of those three types of injury suffices for that provision to apply (judgment of 27 November 2008, *Intel Corporation*, C-252/07, EU:C:2008:655, paragraph 28).
- 75 Secondly, although the proprietor of the earlier trade mark is not required to demonstrate actual and present injury to its mark for the purposes of Article 8(5) of Regulation No 207/2009, it must, however, prove that there is a serious risk that such an injury will occur in the future (judgment of 27 November 2008, *Intel Corporation*, C-252/07, EU:C:2008:655, paragraph 38).
- 76 The existence of one of the types of injury referred to in that provision, or a serious risk that such an injury will occur in the future, must be assessed globally, taking into account all factors relevant to the circumstances of the case, which include the strength of the earlier mark's reputation, the degree of the

earlier mark's distinctive character, the degree of similarity between the opposing marks, and the nature and degree of closeness of the goods and services concerned (judgment of 27 November 2008, *Intel Corporation*, C-252/07, EU:C:2008:655, paragraph 68).

- 77 As regards, in particular, detriment to the distinctive character of the earlier trade mark, also referred to as 'dilution', 'whittling away' or 'blurring', such detriment is caused when that mark's ability to identify the goods or services for which it is registered and used as coming from the proprietor of that mark is weakened, since use of the later mark leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is notably the case when the earlier mark, which used to arouse immediate association with the goods and services for which it is registered, is no longer capable of doing so (judgment of 27 November 2008, *Intel Corporation*, C-252/07, EU:C:2008:655, paragraph 29).
- 78 The Court has also made clear that proof that the use of the later mark is or would be likely to be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious risk that such a change will occur in the future (judgment of 27 November 2008, *Intel Corporation*, C-252/07, EU:C:2008:655, paragraph 77).
- 79 In the present case, in paragraph 43 of the judgments under appeal, the General Court held that the applicant had not submitted to the Board of Appeal or the General Court consistent evidence from which it may be concluded that the use of the marks applied for 'takes unfair advantage of the distinctive character or the repute of the earlier trade marks', thereby referring only to one of the three types of detriment covered by Article 8(5) of Regulation No 207/2009.
- 80 The General Court justified that finding, in paragraph 44 of the judgments under appeal, by stating that the applicant had not 'provided ... evidence capable of substantiating the fact that the use of the mark applied for would make its earlier marks less attractive'.
- 81 First, the ambiguous reference by the General Court to a possible reduction in the 'attractiveness' of the earlier trade marks cannot confirm beyond all doubt that it did in fact assess whether there was a risk of detriment to the distinctive character or the repute of the earlier trade marks, within the meaning of Article 8(5) of Regulation No 207/2009. Secondly, the finding that there was no risk of such a reduction in attractiveness is not, in any event, capable of proving that there was no risk of unfair advantage being taken of the distinctive character or the repute of the earlier trade marks, within the meaning of the same provision.
- 82 In paragraph 45 of the judgments under appeal, the General Court added that 'the fact that another economic agent may be authorised to use a mark including the word "burlington", for goods similar to those on sale in the applicant's London arcade, is not such in itself as to affect, in the eyes of the average consumer, the commercial attractiveness of that place'.
- 83 However, the General Court's finding, if true, does not relate directly to any of the three types of detriment referred to in Article 8(5) of Regulation No 207/2009. The latter do not concern the 'commercial attractiveness' of a place designated by an earlier trade mark, but the risk that the use without due cause of the mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.
- 84 It follows from all the foregoing considerations that the General Court did not assess the evidence provided by Tulli Allan Burlington in support of the ground of opposition based on Article 8(5) of Regulation No 207/2009, in terms of the criteria laid down in that provision and, therefore, erred in law.

85 The second part of the first ground of appeal is, therefore, well founded. Consequently, the first ground of appeal must be upheld, and there is no need to examine the third part of that ground.

The second ground of the appeals

Arguments of the parties

86 The second ground relied on in support of the appeals is divided into two parts. The first part alleges an infringement of the right to be heard and the second an infringement of Article 8(4) of Regulation No 207/2009 relating to the action for passing-off.

87 As regards the first part of the second ground, Tulliallan Burlington states that the Opposition Division assessed the validity of the marks applied for only on the basis of the earlier EU trade mark and in the light of Article 8(5) of Regulation No 207/2009.

88 Tulliallan Burlington, which had also put forward grounds of opposition based on Article 8(1) and (4) of that regulation, maintained each of its grounds of opposition before the Fourth Board of Appeal. In its letter of 28 September 2015, the Board of Appeal expressed its intention to review the cases also on the basis of the earlier United Kingdom trade mark No 2314343 and invited comment from the parties in relation to that mark, but it did not express any intention to review the cases on any other ground, nor did it seek comment from the parties in respect of any other ground.

89 Tulliallan Burlington complains, therefore, that the General Court failed to acknowledge that the Fourth Board of Appeal ought to have invited the parties to submit their observations concerning Article 8(4) of Regulation No 207/2009. In paragraph 54 of the judgments under appeal, the General Court stated that the Fourth Board of Appeal was not required to request additional observations from the parties, which, Tulliallan Burlington submits, would infringe the right to be heard, unless only the question relating to Article 8(5) of that regulation were adjudicated upon.

90 By the second part of its second ground of appeal, Tulliallan Burlington complains that the General Court held, in paragraph 62 of the judgments under appeal, that it had not proven that the conditions of Article 8(4) of Regulation No 207/2009 had been met. More specifically, Tulliallan Burlington complains that the General Court's conclusions were mistaken, in the light of the evidence on the earlier trade marks' reputation available to the Fourth Board of Appeal.

91 EUIPO and Burlington Fashion contend that the second ground raised in support of the appeals must be rejected.

Findings of the Court

92 By the first part of the second ground of appeal, Tulliallan Burlington complains that the General Court infringed its right to be heard in that it failed to acknowledge that the Fourth Board of Appeal ought to have invited the parties to submit their observations concerning Article 8(4) of Regulation No 207/2009 in so far as it intended to address that question, unlike the EUIPO's Opposition Division.

93 It follows from Article 75 of Regulation No 207/2009 that the decisions of EUIPO are to be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments. That provision sets out the right to be heard in the procedure before EUIPO.

- 94 The right to be heard extends to all the factual and legal material which forms the basis for the decision, but not to the final position which the authority intends to adopt (order of 8 September 2015, *DTL Corporación v OHIM*, C-62/15 P, not published, EU:C:2015:568, paragraph 45). That right does not require that, before taking a final position on the assessment of the evidence submitted by a party, the Board of Appeal of EUIPO must offer that party a further opportunity to comment on that evidence (judgment of 19 January 2012, *OHIM v Nike International*, C-53/11 P, EU:C:2012:27, paragraph 53). In addition, a party which itself submitted the facts and evidence in question was by definition in a position to state their possible relevance to the resolution of the dispute at the time when it submitted them (order of 4 March 2010, *Kaul v OHIM*, C-193/09 P, not published, EU:C:2010:121, paragraph 66).
- 95 In the present case, Tulliallan Burlington itself relied, as one of its grounds of opposition, on Article 8(4) of Regulation No 207/2009 and was able to submit, in that regard, the arguments and evidence it considered relevant.
- 96 The General Court pointed out, in paragraph 53 of the judgments under appeal, that it was apparent from the file in the case at issue that, throughout the proceedings before the adjudicating bodies of EUIPO, Tulliallan Burlington had indeed been in a position to submit its observations. Tulliallan Burlington does not challenge that statement and acknowledges itself, in its present appeals, that, in its observations of 20 February 2014 lodged before the Fourth Board of Appeal, it had stated that it maintained each of its grounds of opposition, including that based on Article 8(4) of Regulation No 207/2009.
- 97 In addition, as the Court of Justice held in its judgment of 13 March 2007, *OHIM v Kaul* (C-29/05 P, EU:C:2007:162, paragraph 57), through the effect of the appeal brought before it, the Board of Appeal is called upon to carry out a new, full examination of the merits of the opposition, in terms of both law and fact. It follows that, in the present case, the Board of Appeal was required to carry out a new examination of all the grounds of opposition relied on by Tulliallan Burlington, including, in particular, that based on Article 8(4) of Regulation No 207/2009. Tulliallan Burlington could, therefore, put forward, in its observations before the Board of Appeal, any additional argument which it considered relevant in respect of that ground of opposition, and it was not necessary for it to be specifically invited to do so by the Board of Appeal.
- 98 The General Court was, therefore, fully entitled to find that the Fourth Board of Appeal cannot be criticised for not having requested additional observations from the parties in that connection.
- 99 It follows that the first part of the second ground of appeal must be rejected as unfounded.
- 100 By the second part of its second ground of appeal, Tulliallan Burlington complains that the General Court made an error of assessment relating to the evidence provided in support of its opposition based on Article 8(4) of Regulation No 207/2009.
- 101 It is settled case-law of the Court of Justice that under the second subparagraph of Article 256(1) TFEU and the first paragraph of Article 58 of the Statute of the Court of Justice of the European Union, an appeal lies on points of law only. The General Court thus has exclusive jurisdiction to find and appraise the relevant facts and assess the evidence. The appraisal of those facts and the assessment of that evidence thus do not, save where the facts or evidence are distorted, constitute points of law subject, as such, to review by the Court of Justice on appeal (judgment of 13 November 2019, *Outsource Professional Services v EUIPO*, C-528/18 P, not published, EU:C:2019:961, paragraph 47).

- 102 In addition, such distortion must be obvious from the documents in the Court's file, without there being any need to carry out a new assessment of the facts and the evidence. The appellant must indicate precisely the evidence alleged to have been distorted by the General Court and show the errors of appraisal which, in its view, led to that distortion (judgment of 13 November 2019, *Outsource Professional Services v EUIPO*, C-528/18 P, not published, EU:C:2019:961, paragraph 48).
- 103 Tulliallan Burlington submits, in essence, that if the General Court had taken into account the evidence submitted, in the manner advocated by it, it ought to have concluded that passing-off was made out. It must be found that, in so arguing, Tulliallan Burlington simply criticises the factual assessment made in the judgments under appeal and fails to adduce any evidence to prove that the General Court distorted the relevant facts or evidence.
- 104 It follows that the second part of Tulliallan Burlington's second ground of appeal must be rejected as inadmissible.
- 105 Having regard to the foregoing, the second ground raised in support of the appeals must be rejected as being, in part, unfounded and, in part, inadmissible.

The third ground of the appeals

Arguments of the parties

- 106 The third ground relied on in support of the appeals alleges infringements of Article 8(1)(b) of Regulation No 207/2009. That ground is divided into four parts.
- 107 By the first part of the third ground of appeal, Tulliallan Burlington states that the Court of Justice held, in the judgment of 11 October 2017, *EUIPO v Cactus* (C-501/15 P, EU:C:2017:750, paragraph 48), that the requirement arising from the judgment in *Praktiker* that an applicant for a trade mark designating retail services must specify the types of goods to which those services relate did not apply to trade marks that had been granted before the judgment in *Praktiker*. Tulliallan Burlington further submits that the case-law arising from the judgment of 11 October 2017, *EUIPO v Cactus* (C-501/15 P, EU:C:2017:750) should also apply, in accordance with the principle of legal certainty, to the trade mark applications which had been published as at the date of the judgment in *Praktiker* and also to those which had already been filed but with no requests for amendment by EUIPO. The judgment in *Praktiker* is not, therefore, applicable to any of the earlier marks, contrary to what the General Court decided in the judgments under appeal.
- 108 By the second part of the third ground of appeal, Tulliallan Burlington submits that, in any event, the General Court erred in its analysis of the judgment in *Praktiker*. The scope of that judgment is very limited as it concerned specifically only the goods covered by retail services and could not apply in respect of marks designating shopping arcade services.
- 109 By the third part of the third ground of appeal, Tulliallan Burlington submits that, even if the earlier trade marks did in fact fall within the ambit of the judgment in *Praktiker*, the General Court was wrong to conclude that that judgment necessarily precluded a finding of similarity between the signs. That judgment does not enforce such a limitation, since it merely provides guidance on a form of registration that would make the analysis of confusing similarity easier, but it does not prevent the earlier mark holder from availing itself of the protection of Article 8(1)(b) of Regulation No 207/2009 in relation to a later, confusingly similar registration.

- 110 By the fourth part of the third ground of appeal, Tulliallan Burlington submits that, in misinterpreting the judgment in *Praktiker*, the General Court failed to carry out an assessment of the likelihood of confusion or to remit the cases to the Fourth Board of Appeal to do so.
- 111 Burlington Fashion contends that the third ground of appeal must be rejected in its entirety.
- 112 In the first place, contrary to Tulliallan Burlington's assertions, the services covered by the earlier marks did indeed fall under the category of 'retail services'. The General Court was, therefore, fully entitled to hold that those services belonged to that category.
- 113 In the second place, the judgment of 11 October 2017, *EUIPO v Cactus* (C-501/15 P, EU:C:2017:750) cannot invalidate the General Court's conclusion, set out in paragraph 71 of the judgments under appeal. First, in that judgment, the Court of Justice stated that the judgment in *Praktiker* applied only to the marks registered before the date of delivery of that judgment, which was not the case of the earlier EU trade mark. Secondly, even if the judgment in *Praktiker* does not apply directly to the three earlier United Kingdom marks, the Court of Justice stated in its judgment of 11 October 2017, *EUIPO v Cactus* (C-501/15 P, EU:C:2017:750) that the principles of legal certainty and the protection of legitimate expectations had to be taken into account.
- 114 EUIPO contends that some of the arguments in the third ground of appeal are well founded, but only as regards the three earlier United Kingdom marks, with the exception of the earlier EU mark.
- 115 In the first place, the General Court erred in law inasmuch as it applied the judgment in *Praktiker*, when the case-law arising from that judgment was irrelevant to resolving the cases at issue in the light of the three earlier United Kingdom marks. EUIPO notes, in that regard, that in the judgment of 11 October 2017, *EUIPO v Cactus* (C-501/15 P, EU:C:2017:750), the Court of Justice held that it is apparent from the judgment in *Praktiker* that the scope of the protection of a trade mark registered before the delivery of that judgment cannot be affected by the authority derived from the judgment in *Praktiker* in so far as that judgment concerns only new applications for registration.
- 116 Consequently, the Court expressly rejected any retroactive effects of the judgment in *Praktiker* to trade marks already registered before the date on which it was delivered. In the present cases, the three earlier United Kingdom marks were registered in 2003, thus well before the judgment in *Praktiker* was delivered on 7 July 2005.
- 117 The General Court's findings in the judgments under appeal that the goods designated by the marks applied for and the shopping arcade services were dissimilar is based on the erroneous premiss that the case-law arising from the judgment in *Praktiker* applies to the present case.
- 118 EUIPO contends, therefore, that the General Court erred in law by applying the case-law arising from *Praktiker* to the three earlier United Kingdom marks.
- 119 In the second place, EUIPO argues that the General Court also disregarded the requests for proof of use of the three earlier United Kingdom marks. EUIPO states, first, that the Opposition Division had upheld the oppositions solely on the basis of the earlier EU trade mark and had considered that, for reasons of procedural economy, an examination of the evidence of use filed for those three marks was not necessary. Secondly, EUIPO observes that the Fourth Board of Appeal, without examining the requests for proof of use, reversed the decisions of the Opposition Division and rejected the oppositions with regard to Article 8(1)(b) of Regulation No 207/2009, finding, without any further clarification, that the contested goods were dissimilar to the shopping arcade services in Class 35 within the meaning of the Nice Agreement.

- 120 Had the requests for proof of use been examined, it would potentially have been possible to determine which specific goods were the subject of the ‘shopping arcade/retail services’ that Tulliallan Burlington provided under the three earlier United Kingdom marks. The exact scope of those three earlier marks would have been determinable, in so far as the specific goods covered by the shopping arcade services could have been determined. This follows both from Article 42(2) and (3) of Regulation No 207/2009 and from the judgment of 11 October 2017, *EUIPO v Cactus* (C-501/15 P, EU:C:2017:750, paragraph 50).
- 121 Accordingly, by failing to examine the evidence of use of the three earlier United Kingdom marks, while dismissing the appeals based on 8(1)(b) of Regulation No 207/2009, on the ground that the goods were dissimilar, the Fourth Board of Appeal committed an error of law, which was perpetuated by the General Court. EUIPO contends, by contrast, that the General Court did not err in law as regards the assessment of the likelihood of confusion in the light of the earlier EU trade mark.
- 122 EUIPO contends that the remaining arguments should be rejected.

Findings of the Court

- 123 By the different parts of the third ground of appeal, which must be examined together, Tulliallan Burlington complains, in essence, that the General Court erred in law, in that it incorrectly relied on the judgment in *Praktiker* in order to find, in paragraph 71 of the judgments under appeal, that no similarity or complementarity could be established between the services covered by the earlier trade marks and the goods covered by the marks applied for.
- 124 In that regard, it must be borne in mind that, as regards retail services in Class 35, within the meaning of the Nice Agreement, the Court has held that the objective of retail trade is the sale of goods to consumers. That activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction (see, to that effect, judgment in *Praktiker*, paragraph 34).
- 125 In addition, it must be pointed out that the explanatory note relating to Class 35, within the meaning of the Nice Agreement, states that that class includes, in particular, the bringing together, for the benefit of others, of a variety of goods, excluding the transport thereof, enabling customers to conveniently view and purchase those goods. Those services may be provided by retail stores, wholesale outlets, through vending machines, mail order catalogues or by means of electronic media, for example, through web sites or television shopping programmes.
- 126 It follows from that explanatory note that the concept of ‘retail services’ relates to three essential characteristics, namely, first, the purpose of those services is the sale of goods to consumers, secondly, they are addressed to the consumer with a view to enabling him or her to conveniently view and purchase those goods and, thirdly, they are provided for the benefit of others.
- 127 Accordingly, the concept of ‘retail services’ covers services which are aimed at the consumer and which consist, on behalf of the businesses occupying a shopping arcade’s stores, in bringing together a variety of goods in a range of stores enabling the consumer to conveniently view and purchase those goods and in offering a variety of services separate from the act of sale, which seek to ensure that that consumer purchases the goods sold in those stores.
- 128 It follows from the foregoing considerations that, as the General Court itself correctly held in paragraph 32 of the judgments under appeal, the Court of Justice’s interpretation in paragraph 34 of the judgment in *Praktiker* does not support the assertion that the services provided by shopping arcades or shopping centres are, by definition, excluded from the scope of the concept of ‘retail services’ defined in Class 35, within the meaning of the Nice Agreement.

- 129 The General Court also correctly found, in paragraph 33 of the judgments under appeal, that the Court of Justice's interpretation in paragraph 34 of the judgment in *Praktiker* precludes the argument that shopping arcade services are essentially limited to rental and real estate management services. The General Court states that the concept of 'a variety of services', as mentioned in that paragraph of the judgment in *Praktiker*, necessarily includes the services organised by a shopping arcade in order to retain all the attractiveness and practical advantages of such a place of commerce, the aim being to enable the customers interested by the various goods to conveniently view and purchase them in a range of stores.
- 130 Consequently, the General Court was fully entitled to find, in paragraph 34 of the judgments under appeal, that the concept of 'retail services' includes a shopping arcade's services aimed at the consumer with a view to enabling him or her to conveniently view and purchase those goods, for the benefit of the businesses occupying the arcade concerned.
- 131 In paragraphs 70 and 71 of the judgments under appeal, the General Court found that, as regards the services in Class 35, within the meaning of the Nice Agreement, the EU judicature has established that, for the retail services, it was necessary for the goods offered for sale to be precisely specified. It deduced from this that the absence of any precise statement of the goods which may be sold in the various shops comprising a shopping arcade such as Burlington Arcade precludes any association between those shops and the goods of the mark applied for, since the definition provided by Tulliallan Burlington in the present case relating to luxury goods is insufficient in order to specify the goods concerned. Consequently, according to the General Court, in the absence of such a specification, no similarity or complementarity can be established between the services covered by the earlier trade marks and the goods covered by the marks applied for.
- 132 In that regard, admittedly, the Court of Justice has held that, for the purposes of registration of a trade mark covering services provided in connection with retail trade, it is not necessary to specify in detail the service or services for which that registration is sought, but that, on the other hand, the applicant must be required to specify the goods or types of goods to which those services relate (judgment in *Praktiker*, paragraphs 49 and 50).
- 133 However, first, the Court has made clear that the line of authority derived from the judgment in *Praktiker* concerns only applications for registration as trade marks and does not concern the protection of trade marks registered at the date of that judgment's delivery (judgment of 11 October 2017, *EUIPO v Cactus*, C-501/15 P, EU:C:2017:750, paragraph 45). Since in the present case Tulliallan Burlington's three earlier United Kingdom trade marks, which Tulliallan Burlington relied on in support of its opposition, were registered before the date on which the judgment in *Praktiker* was delivered, they were not, in any event, concerned by the obligation arising from that judgment.
- 134 Secondly, it cannot be inferred from the considerations in the judgment in *Praktiker* mentioned in paragraph 132 of the present judgment that, when a trade mark covering retail services, registered after that judgment's delivery, is relied on in support of the ground of opposition referred to in Article 8(1)(b) of Regulation No 207/2009, that ground of opposition may be rejected from the outset, simply by invoking the absence of any precise statement of the goods to which the retail services covered by the earlier trade mark may relate.
- 135 To act in such a manner would mean that the earlier trade mark is precluded from being relied upon in opposition in order to prevent the registration of an identical or similar mark in respect of similar goods or services and, consequently, refuse to recognise it as having any distinctive character, even though that mark is still registered and it has not been declared invalid on one of the grounds laid down in Regulation No 207/2009.

- 136 In addition, as EUIPO in essence notes, it is possible, by means of a request seeking proof of genuine use of the earlier trade mark, within the meaning of Article 42(2) of Regulation No 207/2009, to determine the precise goods covered by the services for which the earlier trade mark was used and, therefore, pursuant to the last sentence of that paragraph, to take into account, for the purposes of the examination of the opposition, only those goods.
- 137 Accordingly, it is apparent from all the foregoing considerations that, in finding, in paragraph 71 of the judgments under appeal, that the absence of any precise statement of the goods which may be sold in the various shops comprising a shopping arcade, such as the shopping arcade referred to by the earlier trade marks, precluded any association between those shops and the goods of the mark applied for, the General Court erred in law. Consequently, the third ground of appeal must be upheld, there being no need to examine Tulliallan Burlington's remaining arguments.

The actions at first instance

- 138 In accordance with the first paragraph of Article 61 of the Statute of the Court of Justice of the European Union, if the Court of Justice quashes the decision of the General Court, it may itself give final judgment in the matter, where the state of the proceedings so permits. That is so in this instance in the four cases.
- 139 By the first plea in law in the application submitted to the General Court, Tulliallan Burlington complains, in essence, that the Fourth Board of Appeal infringed Article 8(5) of Regulation No 207/2009.
- 140 In particular, it is argued that the Fourth Board of Appeal misconstrued the concept of 'retail services' designating some of the services in Class 35, within the meaning of the Nice Agreement, in respect of which the earlier marks' reputation had not been established.
- 141 In addition, by the third plea in law in that application, Tulliallan Burlington complains, in essence, that the Fourth Board of Appeal infringed Article 8(1)(b) of that regulation, on the ground, in particular, that it failed to take into account the fact that the consumers at whom the services of Tulliallan Burlington's shopping arcade are aimed are the same as those at whom the goods covered by the marks applied for are aimed.
- 142 In paragraph 18 of the decisions at issue, the Fourth Board of Appeal found that Tulliallan Burlington's business is not connected with retail trade and consists solely in renting shops and offices in its shopping arcade. It concluded from this that Tulliallan Burlington provides only real estate management services to its customers, not retail services.
- 143 In that regard, it follows from paragraphs 124 to 127 of the present judgment that the concept of 'retail services' includes, in particular, the services provided by a shopping arcade aimed at consumers with a view to enabling them to conveniently view and purchase goods, for the benefit of the businesses occupying the arcade concerned.
- 144 Accordingly, in adopting a restrictive definition of the concept of 'retail services' and failing to take into account the fact that Tulliallan Burlington provided such services, the Fourth Board of Appeal, first, erred in law in that it conferred too restrictive a scope on that concept and, secondly, failed to characterise the facts correctly.
- 145 Consequently, the first and third pleas in law in the actions must be upheld and the decisions at issue annulled, and there is no need to examine the other pleas in the applications.

Costs

- ¹⁴⁶ Under Article 184(2) of the Rules of Procedure of the Court of Justice, where the appeal is well founded and the Court itself gives final judgment in the case, the Court is to make a decision as to costs.
- ¹⁴⁷ Under Article 138(1) of those rules, applicable to the procedure on an appeal by virtue of Article 184(1) thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.
- ¹⁴⁸ Since Tulliallan Burlington has requested that EUIPO and Burlington Fashion be ordered to pay the costs, and the latter have been unsuccessful, EUIPO and Burlington Fashion must be ordered to bear their own costs and to pay, in equal shares, the costs incurred by Tulliallan Burlington both in relation to the first-instance proceedings in Cases T-120/16 to T-123/16 and the procedures on appeal.

On those grounds, the Court (Fourth Chamber) hereby:

- 1. Sets aside the judgments of the General Court of the European Union of 6 December 2017, *Tulliallan Burlington v EUIPO — Burlington Fashion (Burlington)* (T-120/16, EU:T:2017:873), of 6 December 2017, *Tulliallan Burlington v EUIPO — Burlington Fashion (BURLINGTON THE ORIGINAL)* (T-121/16, not published, EU:T:2017:872), of 6 December 2017, *Tulliallan Burlington v EUIPO — Burlington Fashion (Burlington)* (T-122/16, not published, EU:T:2017:871), and of 6 December 2017, *Tulliallan Burlington v EUIPO — Burlington Fashion (BURLINGTON)* (T-123/16, not published, EU:T:2017:870);**
- 2. Annuls the decisions of the Fourth Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 11 January 2016 (Cases R 94/2014-4, R 2501/2013-4, R 2409/2013-4 and R 1635/2013-4) relating to four sets of opposition proceedings between Tulliallan Burlington Ltd and Burlington Fashion GmbH;**
- 3. Orders Burlington Fashion GmbH and the European Union Intellectual Property Office (EUIPO) to bear their own costs and to pay those incurred by Tulliallan Burlington Ltd in relation both to the first-instance proceedings in Cases T-120/16 to T-123/16 and the procedures on appeal, in equal shares.**

Vilaras

Rodin

Šváby

Jürimäe

Piçarra

Delivered in open court in Luxembourg on 4 March 2020.

A. Calot Escobar
Registrar

M. Vilaras
President of the Fourth Chamber